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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
<i>Chen</i>	)	Group No.: 2833
	)	
Serial No.: 10/721,696	)	Examiner: Nguyen, Truc
	)	
Filed: 25 November 2003	)	Docket No.: 555255012646
	)	

For: ***SURFACE MOUNTABLE CLIP SUITABLE FOR USE IN A MOBILE  
COMMUNICATION DEVICE***

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO RESTRICTION/ELECTION REQUIREMENT**

In response to the Restriction Requirement mailed on 13 January 2005, please consider the following:

*In the mailing of 13 January 2005, a Restriction Requirement was issued for the above-referenced patent application.* In the restriction requirement, the Examiner separated the claims of the present application into three groups, namely Group I “surface mountable clip” claims 1-10; Group II “printed circuit board” claims 11-20; and Group III “mobile communication device” claims 21-30.


The Examiner states that the inventions defined by these groups I, II, and III are distinct. The Examiner indicates that the inventions are related as combination and subcombination and distinctness can be shown where (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. More specifically, the Examiner argues that “the combination as claimed does not require the particulars of the subcombination as claimed because it can be used with different type of retention other than the clip, such as screw or the like.”

In response, the Applicants respectfully disagree with the Examiner and traverse the Examiner’s restriction. The mobile communication device claims 21-30 are specifically directed to use of a surface mountable clip – not a screw. Therefore, the combination as claimed in claims 21-30 can not be used with a different type of retention other than a surface mountable clip as claimed. Furthermore, if there is no evidence that the combination is patentable without the details of the subcombination, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination constitutes the essential distinguishing feature of the combination as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility. See MPEP Sect. 806.05(c) Part II. Notably, the Examiner has failed to provide any evidence that the combination claims are patentable without the details of the subcombination (Group I).

In light of the above, it is clear that the restriction of claims in the present case is not proper. The Applicants respectfully request the Examiner to withdraw the restriction requirement.

Thank you. The Examiner is invited to contact the undersigned by telephone if necessary to expedite this matter. Note that in the event the Examiner continues to disagree, the Applicants hereby elect Group III "mobile communication device" claims 21 – 30 with traverse.

Date: 18 February 2005

Respectfully Submitted,  
  
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